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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,371	06/22/2000	John D. Nelson	101992-200	8796

27267 7590 07/22/2003

WIGGIN & DANA LLP  
ATTENTION: PATENT DOCKETING  
ONE CENTURY TOWER, P.O. BOX 1832  
NEW HAVEN, CT 06508-1832

EXAMINER
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LEVY, NEIL S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 07/22/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.	Applicant(s)
09 592371	NEEDON et al
Examiner	Group Art Unit
MSK Lew	16/6 15

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 4/29/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-3, 5, 8-11, 33, 34, 43-58 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-3, 5, 8-11, 33, 34, 43-58 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. 11 is redundant, now.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 45, 2, 3, 5, 8-11, 46-48, 55-57 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Note that "Azoles" claim 9, would include thiazolinone.

Examiner fails to find support for the negative limitations in the specification, nor any comment certifying no new matter was added. In fact, page 24, top specifically cites strong (otherwise undefined in amended claim language, or specification,) chelating agents of zinc, copper, silver as within the scope of the invention. Absence of chelating agent would be contrary to claim 8-10.

Claims 3, 5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7, 10, 26, 36, 51, 53 and 54 of copending Application No. 09/1599624. Although the conflicting claims

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are not identical, they are not patentably distinct from each other because the claims are obvious variants of each other, as composition, within patentable weight given to intended use.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 48, 50, 52, 54, 56 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of copending Application No. 10/325016. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are obvious, as the concentration recited in the one are within the ratio of the other and the composition are intended to be used as antimicrobials.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-3, 5, 8-11, 33, 34, 43-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Kappock et al 5518774.

The rejection of record is maintained. At col.3, lines 40-46, Kappolk's composition include 0.1% pyrithione and 10% zinc oxide (1:100 ratio as instantly claimed). Compositions can be in shampoos and paints (line 67, col.3). There is no requirement for chelant and thiazolin one evident to examiner. This is a starting material, concentrate, and would still be a concentrate composition, regardless of what its intended use is, and what its effects are, when in contact with this or that surface,

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material or pest, and whether or not diluted; specifically seen as aqueous compositions (col.4, line 65-line 24, col.5).

Claims 33, 34, 43-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Wiese-5227156.

The rejection of record is maintained.

Stabilizer at 0.001% and pyrithione at 0.1% is 1 to 100, the instant ratio (col.3, line 14, 47), after 1:10 dilution in the working fluid (shampoo).

Claims 1-3, 5, 8, 9-11, 45-47, 55 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagata et al-JP-134227. See P.7 of translation: we see 0.01-10% zinc oxide and 0.005-5% zinc pyrithione-no chelate, no thiazolinone-just an aqueous composition, at the instant ratio. Example 1 includes crown ether dilution is shown @ example 4; organic solvents also.

Applicant's arguments filed 4/29/03 have been fully considered but they are not persuasive. Applicants arguments, are seen as directed to the concentration or dilution of the compositions, and argues none of the references alone or in combination, anticipate or make obvious the invention as claimed. We are not convinced.

The well-known, multiuse pyrithiones, and complexes, adducts and chelates thereof, stabilized and unstabilized, have been used for many years as antimicrobial and antifungal agents in compositions ranging from metal working fluids and paints to shampoos. The art addressed is seen as representative of this vast body of knowledge within the purview of the artisan, and readily manipulable and adaptable-However, the art rejects maintained, and the added filter-use compositions, free of offending material,

in fact meet the instant compositions as compositions, regardless of mechanism, functions and intended uses. The dilutions and concentrations are not seen as obvious; they are clearly present in these references, in accord with instant claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is 308-2412. The examiner can normally be reached on Tuesday- Friday 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 308-4556 for regular communications and 872-9307 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1235.

Levy/tgd  
July 10, 2003

A handwritten signature in black ink, appearing to read "Neil Levy". The signature is fluid and cursive, with the first name "Neil" and last name "Levy" clearly distinguishable.

NEIL S. LEVY  
PRIMARY EXAMINER